

REMARKS

This is responsive to the rejection in the Final Office Action mailed December 19, 2006 in which claims 40-61 were rejected. Applicants filed a Notice of Appeal and a suitable petition for extension of time on June 19, 2007. Under the provisions of M.P.E.P. § 706.07(h)(X), Applicants are filing the instant RCE and amendment to withdraw the Appeal and reopen prosecution of the instant application. A petition for a one-month extension of time is enclosed herewith.

Claims 43-44, 48-50 are previously presented, claims 40-42, 45, 47, 51-56, and 58-61 are currently amended, and claims 1-39, 46, and 57 are canceled. New claims 62-67 have been added. No new matter has been added. Reconsideration is requested based on the amendments and remarks presented herein.

Changes to the Claims:

Claims 40, 47, 51, and 58 have been amended to more clearly recite the bounds of the present invention. Other minor claim amendments have been entered, such as to have claims 52-61 properly refer back to the term “system” introduced in claim 51. No new matter has been added.

Rejection under 35 U.S.C. § 112:

Claims 40 and 51 are rejected for reciting the term “accessing resources” more than once without referring back to the first use thereof. Claims 40 and 51 have been amended to remove the recitation of this term. Accordingly, Applicants respectfully contend that this rejection is now moot.

Claims 47 and 58 are rejected for reciting the term “said client computer”. Claims 47 and 58 have been amended to remove the term “client computer” therefrom. Accordingly, it is respectfully submitted that the rejection of claims 47 and 58 are now moot. Reconsideration is respectfully requested.

Rejection under 35 U.S.C. § 101

Claims 40-61 are rejected for being directed to non-statutory subject matter. Since the language regarded as non-tangible by the last Office Action has been modified in this response, the following remarks address the issue of patentability under 35 U.S.C. § 101 of claims 40-61 in their current form.

With regard to rejections under 35 U.S.C. § 101, the M.P.E.P. recites that “[t]he examiner bears the initial burden ... of presenting a prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, then USPTO personnel should not reject the claim. After USPTO personnel identify and explain in the record the reasons why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See M.P.E.P. § 2106 IV.D. (Emphasis added).

In this case, the Office Action merely states the conclusion needed to reject the claims under 35 U.S.C. § 101, namely that claims 40-61 do not produce any tangible results merely by reciting “accessing resources”. Applicants respectfully contend that Office Action language is merely a statement of conclusion and is therefore insufficient to form a prima facie case of unpatentability under the above rule. Accordingly, Applicants respectfully request that the Examiner identify and explain, in light of the applicable standards, why the provision of one-way secure access to servers by client computers and/or to client computers by servers does not qualify as a tangible result under the pertinent provisions of M.P.E.P. § 2106, so that Applicants may have a full and fair opportunity to reply.

Even though Applicants respectfully contend that the Office Action has not stated a prima facie case of unpatentability of Applicants’ claims, Applicants, have nevertheless provided the following remarks regarding the patentability of the currently pending claims under 35 U.S.C. § 101.

The determination whether a claim is directed to statutory subject matter includes a two prong test. First, it must be determined whether the claim falls within one of the judicial exceptions under 35 U.S.C. § 101: abstract ideas, laws of nature, and natural phenomena. M.P.E.P. § 2106 IV.A. If the

claimed subject matter is deemed to fall within one of the above-listed judicial exceptions, a determination must then be made as to whether the claimed subject matter qualifies as a practical application of a judicial exception. See M.P.E.P. § 2106 IV.C.1.

First, Applicants respectfully contend that the claimed subject matter herein is not directed to abstract ideas, laws of nature, or natural phenomena. Applicants respectfully contend that the ability of a service provider to provide secure functionality to plurality of client computers, while protecting the client computers from security breaches from other client computers is clearly not a “law of nature” or a natural phenomenon. Moreover, the claimed feature provides a tangible benefit to a client computer receiving the claimed service and is thus not abstract.

Since the M.P.E.P provides more detailed guidance with respect to evaluating whether the claimed subject matter constitutes a practical application of a judicial exception, attention is now directed to second prong of the test, namely the utility, tangibility, and concreteness of the pending claims, under the standards set forth below.

The Office Action quotes a text passage from MPEP 2106 IV.B.2.(b). at the bottom of page 2 of the Office Action with regard to the “practical application” test. Applicants respectfully note that the portion of the portion of the MPEP quoted on page 2 of the Office Action is from Rev. 3 of the eighth edition of the M.P.E.P. (dated August 2005) and is presented in modified form in the current version of the M.P.E.P. § 2106, as modified November 29, 2006. Accordingly, Applicants have responded to the assertions of non-tangibility employing the legal tests and guidelines present in the most recent version of MPEP Section 2106, to provide a common legal reference point for the Applicants and for the Examiner, and to provide the Applicants with a full and fair opportunity to reply. More specifically, the test for patentability under 35 U.S.C. § 101 is stated in the current version of the M.P.E.P. as follows.

A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it:

- (A) “transforms” an article or physical object to a different state or thing; or
- (B) otherwise produces a useful, concrete, and tangible result, based on the factors discussed below.

See M.P.E.P. § 2106 IV.C.2.

Applicants respectfully contend that the subject matter claimed herein provides a useful, concrete, and tangible result as described below.

Useful, Tangible, and Concrete Result:

The Claimed Subject Matter Produces a Useful Result

Applicants respectfully contend that claims 40, 51, the new independent claims, and the claims dependent thereon, produce a useful result. While some variation in language is recited in different ones of Applicants' claims, it is believed that the following discussion applies to all claims currently pending in the application.

The subject matter claimed herein separates the functions of a service provider that provides services to one or more client computers so as to prevent two-way trusts (transitive trusts) from being in effect between any client computer and any server. As explained in Applicants' specification, the avoidance of two-way trusts enhances the security experienced by individual client computers which are better protected against threats to their security by other client computers. Applicants respectfully contend that this constitutes a useful result in light of the pervasive issue of computer security in today's computing systems, under the standard stated in § 2106.IV.C.2 (2)(a).

The Claimed Subject Matter Produces a Tangible Result

Applicants respectfully contend that the results provided by the claimed subject matter are practical, and in no way "abstract." The provision of a one-way trust that enables, for instance, a client computer to access a set of servers, without that set of servers being able to securely access the client computer in return, enables the client computer to securely access desired data in the set of servers, without exposing its own secure data to access by that set of servers, and thus, possibly by another client having access to that set of servers. Applicants respectfully contend that the above-described outcome is a beneficial, real-world result, and is thus a "tangible result" under the standard in § 2106.IV.C.2 (2)(b).

The Claimed Subject Matter Produces a Concrete Result

The M.P.E.P. recites that the opposite of “concrete” is unrepeatable or unpredictable. See M.P.E.P. § 2106.IV.C.2 (2)(c). Applicants’ claimed subject matter is concrete under this standard. Upon establishing an access system that enables the one-way trusts (or, otherwise stated, one-way secure access) recited in Applicants’ claims, the ability of client computers to securely access data in a first group of servers but to disable this first group of servers from securely accessing data in the client computers in return, such an access system would remain in place for a succession of data access operations. Thus, and data access operations permissible under this scheme would be repeatable and predictable. A similar situation would apply in the reverse direction between the second group of servers and the client computers. Thus, Applicants’ claimed subject matter produces concrete results under the standard in § 2106.IV.C.2 (2)(c).

Based on the foregoing, Applicants’ claims recite patentable subject matter under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 102:

Claims 40-61 are rejected under 35 U.S.C. § 102(e) as being anticipated by Erpeldinger (U.S. Patent No. 6,557,169, hereafter, Erpeldinger). Claim 40 recites the limitation “prohibiting secure access to the plurality of client computers by the first set of one or more servers”. Claim 51 recites similar language. Limitations similar to that quoted above were previously recited in claims 46 and 57, now canceled. Thus, the Office Action remarks used to reject canceled claims 46 and 57 are addressed below.

The Office Action contends that the limitations of claims 46 and 57 (which recited similar limitations) are disclosed in columns 2-3 of Erpeldinger (see Office Action, page 5). However, Applicants have reviewed the cited portions, and respectfully contend that Erpeldinger does not teach the limitations of canceled claims 46 and 57, or of claims 40 and 51, as amended.

Importantly, and with reference to Figure 2 of the present application, the present invention uses two different sets of servers, each of which sets up a secure relationship with the client computers to be managed that is opposite from the other. Specifically, one set of servers securely accesses the client computers without permitting the client computers to securely access the servers. The other set of servers *is securely accessed by* the same client computers without permitting the servers to securely

access those client computers. Thus, the two sets of servers provide services to the client computers, but the trust relationship between each set of servers and the same clients is backwards.

Erpeldinger is directed to a method and system for upgrading the operating system of a workstation in a LAN or WAN without human intervention. See Erpeldinger, title, col. 1 line 67 to col. 2 line 4. In connection with this objective, Erpeldinger describes a server 24 that is coupled to a plurality of workstations and that is operable to transfer application software, including a new operating system to one of the workstations, such as workstation 12, in the pertinent network. See col. 2 lines 59-65. This suggests that server 24 is able to securely access workstation 12, which contradicts the language of claim 40 which recites “prohibiting secure access to the plurality of client computers by the first set of one or more servers”. Further, Erpeldinger does not disclose that any server (server 24 or other server) is prohibited from gaining secure access to workstation 12 or any other workstation. Accordingly, Erpeldinger does not describe all the limitations of claims 40 or 51.

Claims 40 and 51 are therefore patentable over Erpeldinger under 35 U.S.C. § 102. Claims 41-45 and 47-50 depend from claim 40, and claims 52-56 and 59-61 depend from claim 51, and the dependent claims inherit all the limitations of their respective independent claims. The dependent claims are thus patentable over the prior art for the same reasons as claims 40 and 51. Thus, claims 40-45, 47-56, and 59-61 are patentable over the rejection of record.

The New Claims:

Although different language is employed in the new claims (“one-way trust connection” in claims 62-66; and “one-way trust relationship” in claim 67) to define the bounds of the invention, new independent claims 62-67 are believed to be patentable over the prior art for the same reasons as those stated above for claims 40-45, 47-56, and 59-61.

Conclusion:

Applicants respectfully request reconsideration and allowance in view of the above remarks and amendments. The Examiner is authorized to deduct any additional fees believed due from our Deposit Account No. 11-0223.

Respectfully submitted,

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s/Leslie S. Garmaise/
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